

**REMARKS**

Present complication contains claims 1-4 and 6-7. Claims 5 and 8-10 have previously been cancelled.

The Examiner rejected 1, 4 and 6-7 under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Oertel.

The Examiner has provisionally rejected claims 2-3 under 35 U.S.C. § 101 as claiming the same invention as that of claim 1 and 3 of co-pending Application No. 09/701,905. The Examiner further rejected claims 1, 4 and 6-7 provisionally under the judicially created doctrine of obviousness-double-patenting as being unpatentable over claim 1 and 3-6 co-pending Application No. 09/701,905.

With respect to the Provisional double patenting rejections of claims 1-4 and 6-7 based on Application No. 09/701,905 the Examiner is asked to withdrawal these rejections as that application has been abandoned.

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention absence some teaching, suggestion, or motivation that would lead one of ordinary skill in the art to combine the references. In re *Sang Su Lee*, 227 F.3d 1338 (Fed. Cir. 2002), citing *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000); In re *Napier*, 34 U.S.P.Q. 2d 1782 (Fed. Cir. 1995). Elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents. *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2<sup>nd</sup> 1593 (Fed. Cir. 1987). Virtually all inventions are necessarily combinations of old elements and , thus the notion that

combination claims can be declared invalid merely upon the finding of similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under section 103. *Id.* The U.S. Court of Appeals for the Federal Circuit recently made the following statements in *Yamanouchi Pharmaceutical Co., Ltd. v. Merck & Co., Inc.* (No. 99-1521, November, 2000) concerning the combination of old elements:

"Virtually all inventions are combinations of old elements. Therefore, an Examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate the patentability very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention...To counter this potential weakness in the obvious construction, the suggestion to combine requirements stands as a critical safe guard against hindsight analysis and rote application of the legal test for obviousness." [Emphasis added]

Further, when claimed subject matter has been rejected as being obvious in view of a combination of prior art references a proper analysis under section 103 requires a consideration of two factors: [1] Whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and [2] whether the prior art would also have revealed that, in so making or carry out , those of ordinary skill would have a reasonable expectation of success. In re *Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991), In re *Dow Chemical Company.*, 5 USPQ2nd 1529 (Fed. Cir. 1988). Both the

suggestion and the reasonable expectation of success must be found in the prior art not in the applicant's disclosure. *Id.*

When analyzing the issue of obviousness, the differences between the prior art and the claims that issue must be ascertained. *Graham v. John Deer Co.* 128 USPQ 459 (Sup.Ct.1996). In conjunction with the first three "Graham factors" personal of the US Patent and Trademark Office should: (1) Determine the "scope and content of the prior art"; (2) Ascertain the "differences between the prior art and the claims that issue"; and (3) Determine the "level of ordinary skill in the art". Official Gazette, 1196 OG 38, March 11, 1997. With respect to the scope and content of the prior art each reference must qualify as prior art under 35 U.S.C. § 102, and should be in the field of the applicant's endeavor or be reasonably pertinent to the particular problem with which the inventor was concerned. *Id.* The mere fact that the prior art can be modified does not make the modification obvious unless prior art taught or suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

Obviousness may not be established by hindsight. *Kahn v. General Motors Corp.* , 45 USPQ2nd 1608 (Fed. Cir. 1998). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *In re ATD Corp v. Lydal, Inc.*, 48 USPQ2nd 1321 (Fed.Cir.1998). Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight. *In re Dembiczaik*, 50 USPQ2nd 1614 (Fed. Cir. 1999). The prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination. *In re Fromsom v. Advanced Offset Plate Inc.*, 225 USPQ 26 (Fed. Cir. 1985).

Good ideas may well appear "obvious" after they have been disclosed after despite having been previously unrecognized. In re *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.* 43 USPQ2nd 1294 (Fed. Cir. 1997).

The present invention is directed to a composite element having a layered structure wherein an inner layer having dimensions of 10 to 100 mil. in thickness is formed by the reaction product of a mixture of at least one polyphenylpolymethylene polyisocyanate and at least one isomer of diphenylmethane diisocyanate with polyether polyalcohols, optionally in the presence of a catalyst and/or auxiliaries and/or additives. The inner layer is sandwiched between two metal layers each having a thickness of 2-20 mil. The inner layer is also required to have specific characteristics of elasticity, adhesion, elongation, tensile strength and compressive strength. The Kennedy reference that the Examiner is relying on has been discussed repeatedly in extensive detail throughout the prosecution of this application. The Examiner must freely admit there is no disclosure in Kennedy what-so-ever of the components of the inner layer of Kennedy except for that described in column 4 lines 39-41 wherein Kennedy states "The elastomer therefore essentially comprises a polyol e.g. polyester or polyether together with an isocyanate or a di-isocyanate a chain extender and a filler."

This is the complete extent of the disclosure by Kennedy of the elastomer layer. Nowhere does Kennedy discuss, teach, or suggest the advantages found by applicants of utilizing a mixture of at least one polyphenylpolymethylene polyisocyanate with at least isomer of diphenylmethane diisocyanate in the formation of an elastomer for applicant's invention. The Examiner then plucks from the prior art the article by Oertel which suggests that among the isocyanates that could be utilized in forming an elastomer is a combination of MDI with small

amounts of polymeric MDI. The Examiner suggests that the teaching of Oertel that this combination lowers the melting point of the MDI would somehow be beneficial for applicant's invention. Examiner is engaging in the essence of hindsight in combining these two references. There is no suggestion within applicants specification or the claims that melting temperature of the isocyanate portion of the reaction mixture has anything what-so-ever to do in any beneficial manner with applicants invention. Likewise, the Examiner can point to nothing within either of the references that would lead one of ordinary skill in the art to combine them with the expectation that they would lead to applicants invention. As stated above the primary reference Kennedy has not disclosure of the identity of the isocyanate components that are of any use in the preparing the elastomer nor does Kennedy have any disclosure of any of the other components other than that the broad categories are stated. Kennedy merely states what is known by anyone of any skill within the art that an elastomer can be prepared by combining an isocyanate with a polyester or polyether.

Absent any teaching, suggestion, or motivation for combining the prior art references the Examiner has failed to make out a prima facie case of obviousness with respect to applicants claims. Therefore, the Examiner is requested to withdraw the rejection based on the cited references. Even were the Examiner able to make a prima facie case of obviousness using cited references the combination fails to make the applicant's invention obvious. On page 390 which the Examiner references Oertel lists an entire page full of isocyanates and diisocyanates that may find some use in some elastomer formation process. This is not a teaching, suggestion, or motivation that would lead one of ordinary skill in the art when combined with Kennedy to applicant's invention.

In summary, the Examiner has failed to make a prima facie case of obviousness and even if the prima facie case of obviousness is made the references when combined do not in fact make the invention obvious. Therefore, the Examiner is requested to withdrawal the rejection of claims 1, 4, 6 and 7 based on the cited references.

Applicants' attorney respectfully submits that the claims as amended are now in condition for allowance and respectfully requests such allowance.

**Respectfully submitted,**

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